

Appl. No.: 10/656,893
Amdt. dated 04/24/2006
Reply to Office action of November 2, 2005

REMARKS/ARGUMENTS

Applicants respectfully request consideration of the present application in view of the amendments above and the following remarks, which are responsive to the Office Action mailed November 2, 2005. Following such changes, Claims 13 and 15-18 remain pending in the application, and Claims 1-11, 12, and 14 have been cancelled.

In the Office Action, Claims 12-16 were noted as pending in the application. The Examiner objected to the abstract under MPEP § 608.01(b) rejected Claims 12-16 under 35 U.S.C. § 112, paragraph 2 and 35 U.S.C. § 103(a). The objections and rejections are addressed separately below.

Objection of the Abstract under MPEP § 608.01(b)

On page 3 of the Office Action, the Examiner objected to the abstract of the disclosure under MPEP § 609.01(b), asserting that the Abstract "contains multiple punctuation and grammatical errors." Applicants have provided a replacement paragraph for the Abstract that corrects the punctuation and grammatical errors and provides additional clarity to the Abstract. In light of the amendments to the Abstract, Applicants respectfully request that this objection be withdrawn.

Rejection of Claims 12-16 under 35 U.S.C. § 112, paragraph 2

On pages 3-4 of the Office Action, the Examiner rejected Claims 12-16 under 35 U.S.C. § 112, paragraph 2. In particular, the Examiner asserts that Claims 12-14 are "incomplete for omitting essential steps" including "breaking of the tile along the breakage channels." In response, Applicants have canceled Claims 12 and 14 and have amended Claim 13 to include the steps of breaking the second tile shape along the first breakage channel and breaking the cap portion of the second tile shape along the second breakage channel.

In addition, the Examiner asserts that Claims 12 and 13 are indefinite because "it appears to be unclear and indefinite which two of the three [portions of the second tile shape] simulate the mission-shaped tiles" and "which [portion] is to be placed atop the cap portion of the S-

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shaped tile because two of the three parts could be the 'shorter' mission-shaped tile." In response, Applicants have amended Claim 13 to specify that each of the two cap portion sections and the pan section have a generally "C"-shaped transverse cross section. In addition, Applicants have amended Claim 13 to include the step of attaching one of the two cap portion sections of the second tile shape atop the cap portion of the first tile shape. As mentioned above, Claim 12 has been canceled.

The Examiner also asserts that Claims 12-14 are indefinite because "it is unclear to the Examiner and indefinite a) which portion of the first tile is intended to be the cap portion, and b) in what configuration the shorter of the two mission-shaped tiles is installed on the cap portion." In response, Applicants have amended Claim 13 to specify that the cap portion defines a concave surface relative to a supporting surface. In addition, Applicants have canceled Claims 12 and 14.

Furthermore, the Examiner asserts that Claims 15 and 16 are indefinite because after considering "the claims in light of the specification (Page 7, lines 18-33), [the Examiner] can find no clear definition or description of a 'slipper.'" Applicants respectfully note that the term "slipper" is well known in the art of roofing tile manufacturing to refer to a part that corresponds with a mold to form and shape the surface of the roofing tile opposite the side adjacent the mold (*see, e.g.*, U.S. Patent Nos. 5,290,355, 5,820,802, and 5,223,200). Because Applicants show an embodiment of a slipper in Figure 3A that is consistent with its ordinary meaning in the art and use this term in Claims 15 and 16 consistently with its ordinary meaning in the art, Applicants respectfully request the Examiner withdraw this rejection.

Thus, in light of the amendments to Claims 13 and 15-16 and the remarks provided above, Applicants respectfully request that the Examiner withdraw the rejection of Claims 13 and 15-16 under § 112, paragraph 2.

Rejection of Claims 12-16 under 35 U.S.C. § 103(a)

On pages 5-8 of the Office Action, the Examiner rejected Claims 12-14 under 35 U.S.C. § 103(a) in light of U.S. Patent No. 3,349,534 to Wotherspoon ("*Wotherspoon*") in view of U.S. Patent No. 2,120,742 to Grundy ("*Grundy*"), U.S. Patent No. 5,326,318 to Rotter ("*Rotter*"), and

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U.S. Patent No. 1,993,086 to Chaffee ("*Chaffee*"). In addition, on pages 8-9 of the Office Action, the Examiner rejected Claim 15 under § 103(a) in light of *Wotherspoon* in view of *Grundy, Chaffee*, and U.S. Patent No. 5,743,059 to Fifield ("*Fifield*"). Furthermore, on page 10 of the Office Action, the Examiner rejected Claim 16 under § 103(a) in light of *Wotherspoon* in view *Chaffee* and *Fifield*.

Applicants have canceled Claims 12 and 14. In addition, Applicants have amended Claims 13 and 15-16, and added new independent Claim 18 and new dependent Claim 17. In light of these amendments, Applicants respectfully assert that *Wotherspoon, Grundy, Rotter, and Chaffee* do not teach or suggest all of the elements of Claims 13, 15-16, and 17, individually or in combination.

Amended Claim 13 recites the steps, *inter alia*, of (1) breaking the second tile along the first breakage channel and (2) breaking the cap portion of the second tile shape along the second breakage channel. Because the prior art cited by the Examiner fails to disclose these two steps individually or in combination, the Applicants respectfully request that the rejection of amended Claim 13 be withdrawn.

Amended Claim 15 recites the steps, *inter alia*, of (1) providing a second tile shape by use of the tile mold used to provide a first tile shape and a second slipper, wherein the second tile shape is an S-tile shape and defines a separation channel on one or more surfaces of the second tile shape and (2) breaking the second tile shape along the separation channel such that the second S-tile shape is converted into two mission tile shapes, one being a "cap" type and one being a "pan" type. Because the prior art cited by the Examiner fails to disclose these two steps individually or in combination, the Applicants respectfully request that the rejection of amended Claim 15 be withdrawn.

Amended Claim 16 recites the step, *inter alia*, of providing a second tile shape by use of a second slipper and the tile mold used to provide a first tile shape, wherein the second tile shape is an S-tile shape and the second slipper provides a simulation interface channel such that the second tile shape simulates tiles each having a generally "C"-shaped transverse cross section. Because the prior art cited by the Examiner fails to disclose this step, the Applicants respectfully request that the rejection of amended Claim 16 be withdrawn.

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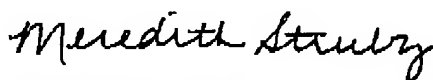
New independent Claim 18 recites the steps, *inter alia*, of (1) providing a second tile shape having a generally "S"-shaped transverse cross section and defining at least one breakage channel for facilitating breakage of the second tile shape between the cap portion and the pan portion and (2) breaking the second tile along the breakage channel. Because the prior art cited by the Examiner fails to disclose these two steps individually or in combination, Applicants respectfully assert that this claim is patentable in light of the prior art.

New dependent Claim 17 provides that (1) the two cap portion sections comprise a first cap portion section and a second cap portion section, wherein the first cap portion section is shorter than the second cap portion section, and (2) the step of attaching one of the cap portion sections atop the cap portion of the first tile shape includes attaching the first cap portion section atop the cap portion of the first tile shape. Applicants assert this claim is patentable because (a) it depends from amended Claim 13 and includes all of the limitation of amended Claim 13, which, as discussed above, is not rendered obvious in light of the prior art, and (b) the limitation of Claim 17 is not taught or suggested by the prior art.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Applicants appreciate the Examiner's careful consideration of this application and would welcome a telephone conference with the Examiner to expedite the processing of the patent application. Applicant's attorney, Meredith Struby, may be reached directly at (404) 881-4626.

Respectfully submitted,



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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.

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04/24/2006
Date